

REMARKS

Claims 1-29 are pending, wherein no claims are amended, withdrawn, canceled, or newly presented. No new matter is introduced.

The final Office Action mailed December 2, 2003 rejected claims 1-3, 6, 7, 9-15, 17-18, and 20-29 under 35 U.S.C. § 103(a) as obvious over *Tönnby et al.* (US 6,515,996) in view of *Itoi* (US 6,456,625), claims 4-5, 16, and 19 under 35 U.S.C. § 103(a) as obvious over *Tönnby et al.* in view of *Itoi* and further in view of *Awadalleh* (US 6,449,251), and claim 8 under 35 U.S.C. § 103(a) as obvious over *Tönnby et al.* in view of *Itoi* and further in view of *Szeliga* (US 6,067,353).

Claim 1 recites “wherein the telephone interface means is adapted to **patch a call from the one telephone to the circuit switched telephone network** via the network interface means upon a determination that no data connection is established to the circuit switched telephone network.” Independent claim 9 recites “wherein the telephone interface means is adapted to **passively patch a call from said telephone to the circuit switched telephone network** via the network interface means.” Independent claim 17 recites “**determining whether a data connection is established with the circuit switched telephone network**” and “**patching a call initiated from the telephone to the circuit switched telephone network** via the network interface means based upon the determining step.” Claim 25 includes the feature of “the plurality of interfaces support **patching a call from the telephone to the circuit switched telephone network upon a determination that no data connection is established to the circuit switched telephone network.**” Claim 26 recites “**determining whether a data connection is established with the circuit switched telephone network**” and “**patching a call initiated from a telephone to the circuit switched telephone network** based upon the determining step.”

To satisfy the above features, the Office Action, on page 3, refers to the movable contact 71 of FIG. 8, and contends “for establishing a telephone call via PSTN if PC does not established [sic] with a service provider.” Applicants respectfully disagree with this assertion, as *Tönnby et al.* provides no disclosure of “a determination that no data connection is established to the circuit switched telephone network.” The above extrapolation ignores the specifics of the claim language.

Tönnby et al. discloses, on col. 8: 52-col. 9: 3, that the IP modem 4 operates into different modes depending on user A's desires and depending on the kind of services required by A. The IP-network and PSTN/ISDN network services available from the IP modem have been described in connection with FIGS. 1-5. In FIG. 6 the basic telephony service is shown. The IP modem 4 comprises a relay 69 with two movable contacts 70, 71. Contact 70 is adapted to be connected the wall socket in A's premises and from there to the subscriber line to the local office. Contact 71 is adapted for connection to user A's telephone loop 57. Each movable contact can move between two stationary contacts, two of which are interconnected by a cable 72. When the movable contacts are in the position shown in FIG. 5 basic telephony mode is provided. When the movable contacts are in their opposite positions the IP mode described in connection with FIGS. 1-5 is provided. In the position shown in FIG. 6 a telephone connection is hard wired through the IP modem. In this position A's telephone apparatus will be connected, usually via a non shown wall socket, to the subscriber line.

As evident from the above discussion, the *Tönnby et al.* system never requires “a determination that no data connection is established to the circuit switched telephone network,” but in fact, circumvents this feature by hardwiring the connections via the movable contacts 70, 71.

Applicants noted this deficiency with respect to the applied reference of *Itoi* in Applicants' previous response dated Mar. 19, 2003. For convenience, this argument is reiterated. *Itoi* is directed to a system supporting speech over an analog telephone set or an Internet phone device in a LAN telephone network (see Abstract). As evident from FIGs. 3A and 3B, and accompany text, the *Itoi* system strictly operates in a LAN environment without any connection to a "circuit switched telephone network," as positively recited in the claims. For example, *Itoi* (col. 10, line 48 – col. 11, line 52), discloses a call control process as described in relation to Figure 10, solely in relation to telephone numbers corresponding to IP addresses, and therefore, cannot operate with a circuit switched telephone network.

On page 5, line 16 – page 6, line 3, the Office Action asserts, "Tonnby discloses the switches for receiving a call setup from a telephone and determining if the modem does not connect with internet service provider via a circuit switched network, the switches will switch to a location so that the call can be routed to the circuit switched network (Fig 6 and 8, the CPU will determine what modes the modem is activate, active mode 'data connection' or de-active mode 'no data connection' in order to control the relay to switch the switches; if data connection has been established or not if not the CPU will control REF 77 and 75 to release the switches to a position to establish a connection between telephone and circuit switched network in order to send a call setup message to the circuit switched network)."

However, Applicants have carefully studied *Tönnby et al.*, and have found no such disclosure or suggestion of "the CPU" determining "what modes the modem is activate, active mode 'data connection' or de-active mode 'no data connection' in order to control the relay to switch the switches; if data connection has been established or not if not the CPU will control REF 77 and 75 to release the switches to a position to establish a connection between telephone and circuit switched network in order to send a call setup message to the circuit switched

network.” The only mention of “mode” starts at col. 9: 47- col. 10: 18: “Local Mode – When power to the IP modem is on and the modem has no connection to the IP network 9 the modem is said to be in its local mode,” followed by a brief discussion of “intercom” and “Connected state mode implies that the IP modem is connected and communicates over the IP protocol layer.”

Therefore, *Tönnby et al.* and *Itoi*, either individually or in combination, fail to disclose the features of the independent claims 1, 9, 17, 25, and 26.

Furthermore, as Applicants have previously pointed out, the Office Action has engaged in impermissible hindsight in proposing the combination of *Tönnby et al.* and *Itoi*. The Office Action, on page 4, states that the motivation to combine the two references “would have been to increase the number of devices that can access the internet.” Not only does this suggested motivation does not stem from any of the references, but the conclusion is factually incorrect. There is no disclosure in *Tönnby et al.* of a need or object to allow more devices to connect to the Internet. Moreover, even the combination of *Tönnby et al.* and *Itoi* does not render this unsupported statement true. That is, the modified *Tönnby et al.* system would not operate to support more devices than the unmodified system. The proposed modification of *Tönnby et al.* to add *Itoi*’s function of providing local IP addresses to the Internet phone devices and to analog telephone sets is unnecessary, adding no extra functionality to the *Tönnby et al.* system, other than complexity and cost. Notably, the *Tönnby et al.* system does not assign internal network addresses for the telephone 1 and the computer 2, but rather employs an external IP address of the subscriber line 5 in the IP modem 4, and provides multiplexor/demultiplexor functions to support multiple devices (col. 17:30-36). Other than simply describing a way that Internet and analog telephones receive IP addresses in a LAN environment, *Itoi* provides no motivation or suggestion to modify the *Tönnby et al.* system in the manner proposed in the Office Action. One of ordinary skill in the art would find no motivation to include an internal network address

assigning function in the IP modem 4 of *Tönnby et al.* to implement an operation that is already performed by the multiplexing and de-multiplexing functions.

The Office Action, on Page 6, line 21 – page 7, line 5, in an apparent defense of the Office Action’s reasoning not being “hindsight reasoning,” states, “But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant’s disclosure, such a reconstruction is proper.” However, as discussed above, the Office Action fails to show how claimed features were “within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant’s disclosure.”

Furthermore, the mere fact that a reference can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP 2143.01. Although a prior art device “maybe capable of being modified to run the way the apparatus is claimed, there must also be a suggestion or motivation in the reference to do so.” *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). Neither *Tönnby et al.* nor *Itoi* provides any suggestion or motivation for the construction proposed by the Office Action. It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicants’ structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

In an attempt to establish some teaching, suggestion, or motivation to combine or modify the references, the Office Action, on page 6, lines 4-16, states, “Tonnyby discloses a device for establishing a telephone via PSTN or internet **by determining the device being connected to data network or not** and if not routing the call via PSTN via the switches in the device by

controlling the switches to switch to a position as showed [sic] in Fig 6 and Itoi discloses a device has a routing means for assigning internal network addresses to said telephone and said computer and routing the voice and data packets according to assigned internal network addresses. The motivation would have been to increase the number of devices can access to the Internet with less external assigned IP addresses.” However, as discussed previously, *Tönnby et al.* does not disclose “**by determining the device being connected to data network or not.**” Additionally, as discussed previously, the proposed modification of *Tönnby et al.* to add *Itoi*’s function of providing local IP addresses to the Internet phone devices and to analog telephone sets is unnecessary, adding no extra functionality to the *Tönnby et al.* system, other than complexity and cost. Notably, the *Tönnby et al.* system does not assign internal network addresses for the telephone 1 and the computer 2, but rather employs an external IP address of the subscriber line 5 in the IP modem 4, and provides multiplexor/demultiplexor functions to support multiple devices (col. 17: 30-36).

The secondary references of *Awdallah et al.* and *Szeliga* do not fill in the gaps of *Tönnby et al.* and *Itoi*. *Awdallah et al.* was applied for features relating to setting priority to the voice and data packets, and *Szeliga* was cited for a supposed teaching of a visual call waiting indicator.

Therefore claims 1, 9, 17, 25, and 26 should be indicated as allowable. Dependent claims 2-8, 10-16, 18-24, and 27-29 are also allowable for at least the same reasons as their independent claims and are separately patentable on their own merits.

For example, claim 6 recites “wherein said routing means **apportions the bandwidth of said subscriber line** for selectively routing the voice signals and data signals between said telephone and computer, respectively, and the circuit switched telephone network.” The Office Action asserts that these features are disclosed by *Tönnby et al.* by stating, “the voice packet and data packet is [sic] simultaneously multiplexed into the subscriber line, Fig 7, Ref 80.”

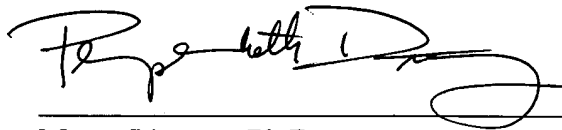
However, at col. 9: 38-44, *Tönnby et al.* states, “There is also an IP MUX/DMUX functionality 80, also referred to as IP router functionality, which takes IP packets from the different interfaces and sends them **in the proper order** to the subscriber line interface 77. The IP MUX/DMUX functionality also provides for reception of IP packets from the subscriber line interface and for delivery of the received IP packets to their proper interfaces.” Applicants respectfully submit that this does not suggest or disclose “wherein said routing means **apportions the bandwidth of said subscriber line** for selectively routing the voice signals and data signals between said telephone and computer, respectively, and the circuit switched telephone network” as recited by Claim 6.

Therefore, the present application, as amended, overcomes the objections and rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at 703-425-6499 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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2/2/04
Date



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